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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/267,639 | 03/15/1999 | TAKU KATOH | 04329.2078 | 7338 |

22852 7590 01/13/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

CALLAHAN, PAUL E

| | |
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| ART UNIT | PAPER NUMBER |
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2137

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,639

Applicant(s)

KATOH ET AL.

Examiner

Paul E. Callahan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-3-2003 has been entered.

2. Claims 1-13 are pending in this case and have been examined.

Response to Arguments

3. Applicant's arguments filed 10-30-2003 have been fully considered but they are not persuasive.

Applicant argues in traverse of the rejections of the claims under 35 U.S.C. 102(b) as found in the previous Office Action in the case as being clearly anticipated by Itami, US Patent 5,418,852.

The Applicant argues that Itami does not teach superimposing an identification information on presentation target data, yet Itami teaches such at col. 14 lines 50-60 where the ID data is taught as being superimposed on a user accessible target data area. From Itami line 56: "However it is possible to record the ID Data on the user accessible area by using an error correction code (ECC) recorded on a sector area accessible in the normal mode." Itami refers to ID Data here, not intentionally incorrect data as the Applicant suggests. Therefore the Applicant's arguments do not distinguish the claimed invention from the teachings of Itami.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 7, 9, and 11-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itami et al. US Patent 5,418,852 23 May 1995.

As per claims 1 and 13, Itami et al teaches: a record medium comprising an original data obtained by superimposing an identification information upon a presentation target data to which an error correction encoding is performed, wherein error correction encoding is applied to an original data, in col. 14 lines 50-68, and col. 15 lines 1-50.

As per claim 3, Itami teaches identification information that is superimposed to a data part stored in an area where a control information of contents data in a record area is recorded. In col. 15 lines 1-50.

As per claim 4, Itami teaches information to acquire a superimposed position of said identification information in col. 14 lines 50-60.

As per claim 7, Itami teaches a superimposed position of said identification information is given by a table form, in col. 14 lines 50-67, and col. 19 lines 1-15.

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As per claim 9; The claim is directed to the computer program product causing a processing device to carry out the method of claim 1 and is therefore rejected on the same basis as that claim.

As per claims 11 and 12: Itami teaches a computer readable record medium on which a program for the computer to function is recorded, comprising a program which when executed causes a processor to carry out the steps of: reading information including identification information superimposed upon presentation target data, decoding means for extracting an identification information from the read information before an original data read from the record medium is error-corrected; judgment means for judging whether a data stored in said record medium based on an identification information extracted to said identification information decoding means is an original data, and for outputting a judgment result, in col. 14 lines 50-67 and col. 15 lines 1-50.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5, 6, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itami et al. US Patent 5,418,85,223 and Sako et al., European Patent Application No. EPO 794 496 A1, 18 June 1996.

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As per claim 2, Itami does not teach said identification information has a plurality of partial identification information, and said plurality of partial identification information are separately superimposed. to a plurality of positions in the presentation target data to which said error correction encoding is performed. Sako does teach this in col. 5 lines 6-37. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature of Sako into the invention of Itami. It would have been desirable to do so as this would allow for a greater amount of identification information to be stored on the disk and therefore make illegal copying more difficult.

As per claims 5 and 6 , Itami teaches: an information to acquire a superimposed position of said identification information has an initial value information, a superimposed position information indicating a superimposed position of identification information, and a position information to acquire a position of said superimposed position information, in col. 14 lines 50-68 and col 15 lines 1-50, a first position information to acquire the position of said superimposed position information is recorded at a position obtained by converting said initial value information by a predetermined function or a position shown by a position obtained as a result of the conversion, and a second or later position information is recorded in another position of the position obtained by converting a storage information of a position of a result when an information stored at another position of a side where said position information is not stored is further converted by said predetermined function in any positions obtained by a conversion result of said predetermined function, or a storage information at a position indicated to a position of a result of conversion one by one .in col. 7 lines 50-67, and col. 8 lines 1-30. However, Itami does not teach said identification information having a plurality of partial identification information. Sako teaches this in col. 5 lines 6-37. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature of Sako into the invention of Itami. It would have been desirable to do so as this would allow for a greater amount of identification information to be stored on the disk and therefore make illegal copying more difficult.

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As per claim 8: Itami does not each presentation target data that is scrambled or encoded to make said identification information a key before an error correction encoding is performed. Sako does teach this in col 5 lines 7-37. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature of Sako into the invention of Itami. It would have been desirable to do so as this would allow for a greater security in the storage of identification information on the disk and therefore make illegal copying more difficult.

As per claim 10, Itami does not teach: for scrambling and-encrypting said presentation target data making said identification information a key, and executing scramble/encryption means for delivering it to error correction encoding means. Sako does teach this in col. 5 lines 7-37. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature of Sako into the invention of Itami. It would have been desirable to do so as this would allow for a greater security in the storage of identification information on the disk and therefore make illegal copying more difficult.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239 (Official Faxes) X-7240 (Unofficial Faxes) and X-7238 (After-Final Faxes).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Paul Callahan
1/8/04


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
CENTER 2100